



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,265	08/27/2001	Paul A. Smethers	3399P061	4538

26529 7590 02/12/2004

BLAKELY SOKOLOFF TAYLOR & ZAFMAN/PDC  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025

EXAMINER
----------

APPIAH, CHARLES NANA

ART UNIT	PAPER NUMBER
----------	--------------

2686

10

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/940,265

**Applicant(s)**

SMETHERS, PAUL A.

**Examiner**

Charles Appiah

**Art Unit**

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) 36-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Applicant's election without traverse of claims 1-35 in Paper No. 9 is acknowledged. Claims 36-71 are withdrawn as being drawn to a non-elected invention.

#### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by **Inoue et al. (6,332,024)**.

Regarding claims 1 and 30 Inoue discloses a method of operating a hand-held mobile device and a handheld mobile device (see Fig. 1A), the method comprising: displaying a softkey indicator on a display of the handheld mobile device, the softkey indicator indicating a corresponding softkey action (see col. 3, lines 25-42), displaying an input field on the display while displaying the softkey indicator (CA1), the input field for receiving characters input by a user using an input device of the handheld mobile device (see Figs. 3, 4B, col. 6, lines 4-54), detecting activation of the input field (see col. 9, lines 39-45), and in response to activation of the input field, automatically

Art Unit: 2686

selecting a softkey action previously associated with the input field and automatically changing the softkey indicator to indicate the selected softkey action (see col. 9, lines 45-58).

Regarding claims 2-4 and 31-33, Inoue further discloses wherein activation of the input field comprises inputting one or more characters in the input field or inputting one or more characters according to a predefined format in the input field and selecting the input field (see Fig. 4B, col. 7, lines 42-67).

Regarding claim 5, Inoue's teaching as illustrated in Figs. 14A-14F shows the capability of executing a browser in the handheld device, the browser enabling a user of the handheld mobile device to navigate hyperlinked content on a data network (see col. 3, lines 8-30, col. 16, lines 1-67).

Regarding claims 6, 7, 34 and 35, Inoue further discloses wherein the input field is a recipient identifier field for receiving an identifier of a recipient of a communication to be initiated from the handheld mobile device, and wherein the softkey action is initiation of the communication wherein the communication is a telephone call, wherein the recipient field is a telephone number input field for receiving a telephone number of party to be called (see col. 7, lines 25-65).

Regarding claims 8, 14, 18 and 24, Inoue discloses a method of operating a browser in a handheld mobile device, a handheld mobile device and a machine readable program storage medium having stored therein a browser useable by a handheld device, the method comprising: displaying a telephone number input field on the display of the handheld mobile device (see CA1 of Fig. 4B), the telephone number

Art Unit: 2686

input field for receiving a telephone number input by a user using an input device of the handheld mobile device (see col. 6, lines 4-54), providing a softkey, including displaying a softkey indicator on the display while displaying the telephone number input field see col. 5, lines 1-42), the softkey indicator indicating a corresponding softkey action of a plurality of softkey actions of the browser (see col. 3, lines 25-42), detecting activation of the telephone number input field (see col. 9, lines 39-45), and in response to activation of the input field, automatically selecting dial action to correspond to the softkey indicator automatically changing the softkey indicator to indicate the dial action, such that the user can initiate a telephone call from the handheld mobile device by entering the telephone number in the telephone number input field and activating the softkey, without additional input being required from the user to initiate the telephone (see col. 7, lines 25-65, col. 9, lines 45-58).

Regarding claims 9, 13, 20 and 26, Inoue's teaching as illustrated in Figs. 14A-14F shows the capability of executing a browser in the handheld device, the browser enabling a user of the handheld mobile device to navigate hyperlinked content on a data network (see col. 3, lines 8-30, col. 16, lines 1-67).

Regarding claims 10-12, 15-17, 21-23 and 27-29 Inoue further discloses wherein activation of the input field comprises inputting one or more characters in the input field or inputting one or more characters according to a predefined format in the input field and selecting the input field (see Fig. 4B, col. 7, lines 42-67).

Regarding claims 19, and 25, Inoue further discloses wherein the handheld mobile device is a mobile telephone configured to operate on a wireless network

Art Unit: 2686

(inherent feature of mobile telephone being capable of making traditional telephone call, col. 5, lines 16-26).

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Smith et al. (6,084,951) discloses a system for providing a directory with graphical icons associated with additional information on a portable communication device.

Frederiksen (6,195,569) discloses a phone with alternative functionality menu display capability.

Gerszberg et al. (6,570,974) discloses a videophone having a touch screen and display with softkeys capable of wireless communication.

Evans et al. (6,650,889) discloses a mobile handset with browser application.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2686

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**